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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,652	02/13/2004	Chee-Keung Chung	33229-200486	5622

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EXAMINER

WARE, DEBORAH K

ART UNIT PAPER NUMBER

1651

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/777,652

Applicant(s)

CHUNG ET AL.

Examiner

Deborah K. Ware

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on amendment of 6/30/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-35 is/are pending in the application.
- 4a) Of the above claim(s) 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-23 and 30-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-5, and 7-35 are presented for reconsideration on the merits.

#### ***Election/Restrictions***

Claims 24-29 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 8, 2004.

Applicant's election with traverse of Group I in the reply filed on November 8, 2004 is acknowledged. The traversal is on the ground(s) that they request that it be withdrawn. This is not found persuasive because of reasons of record.

The requirement is still deemed proper and is therefore made FINAL.

Therefore, since this application contains claims 24-29 drawn to an invention nonelected with traverse in Paper No. November 8, 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Response to Amendment***

The amendment filed June 30, 2005, has been received and entered. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5, 7-23 and 30-35 are rejected under 35 U.S.C. 102(a, b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wong et al (cited on

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PTO-892 Form as a 102(a) reference) or Liu et al (US 6440420), cited on the enclosed PTO-1449 Form.

Claims are drawn to a preparation comprising oleaginous substances extracted from *Ganoderma lucidum*.

Wong et al teach a preparation comprising substances extracted from *Ganoderma lucidum*, note abstract and page 5, column 1, paragraphs 0049-0051.

Liu et al teach a preparation comprising oleaginous substances extracted from *Ganoderma lucidum*.

The claims are considered to be identical to the teachings of the cited references and are therefore, considered to be anticipated by Wong et al or Liu et al. The properties not specifically disclosed by the references, such as tastelessness is considered to be inherent to the properties of the disclosed preparations since they are identical they would be tasteless as well. However, in the alternative that there is some different property of the instant preparation and those of the disclosed prior art then the difference is considered to be so slight as to render the preparation obvious over the cited prior art. Thus, the claims are at least rendered prima facie obvious in the absence of convincing and persuasive evidence to the contrary. The instant preparation would have been an obvious modification of those disclosed in the cited prior art and well within the purview of an ordinary artisan to obtain from the disclosed *Ganoderma lucidum* of the cited prior art.

***Response to Arguments***

Applicant's arguments filed June 30, 2005, have been fully considered but they are not persuasive. The argument that Wong does not disclose Applicants' claimed invention is noted, however, the reference does teach that substances are extracted from *Ganoderma lucidium* and although Applicants may obtain the substance in a different way the process by which the product is obtained does not necessarily render a patentable product unless the product is deemed patentable on its own. With respect to Liu, the argument that this is Applicants' own art is noted but there are different inventor entities of the applied patent and the reference has a good date as well August 27, 2002 under 35 USC 102(b). Applicants do not have any claim to an earlier priority date. Further, the extraction method would inherently provide for an external preparation as claimed because it is the same material being extracted as claimed herein. Also whether or not there is any disclosure of applying to the skin does not remove the reference as prior art since such application has no bearing on providing for a different product, the product is identical to Liu et al.

With respect to alternative argument under 35 USC 103, the above rebuttal arguments may also be presented for an argument regarding the expectation of successful results of the product obtained by Liu et al and Wong. An external preparation as claimed if not clearly anticipated, would have been at least suggested by the cited prior art combination. An external preparation would have been an obvious modification because it is the same composition which may have many different uses

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but the use of a product as discussed above, is not necessarily given any patentable weight.

Thus, the properties as discussed by Applicants are not really properties of the product, so long as the product is the same as disclosed then the claimed product is anticipated, or at least obvious in the absence of some claimed unidentified characteristic of the product itself other than an effect it may be capable of providing when used in a different way. Hence, whether the product is tasteless or capable of lessening skin inflammation, etc is not enough to make the product different if it is disclosed to possess the same ingredients and chemical properties with respect to what is contained in the claimed product. Therefore, the claims are deemed to be obvious in the alternative if they are not anticipated by the cited references.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-23 and 30-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 11 of U.S. Patent No. 6,440,420. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims drawn to a composition would have been obvious from a method for reextracting oleaginous substances from spores by extracting the substances from sporodermbroken *Gandoderma* spores using a SCF-Carbon dioxide method as claimed herein. One of skill would have been motivated to carry out the process steps of the patented claims to obtain the product as claimed herein. Thus, the claims are prima facie obvious.

All claims fail to be patentably distinguishable over the state of the art discussed above. Therefore, the claims are properly rejected.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 561-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Deborah K. Ware  
September 19, 2005



DAVID M. NAFF  
PRIMARY EXAMINER  
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